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First Named Inventor	Boal
Group Art Unit	3622
Examiner Name	James W. Myhre
Attorney Docket Number	15874-019001

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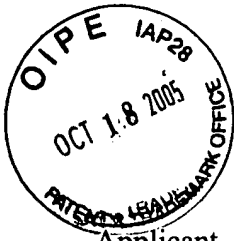
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Boal
Serial No. : 09/451,160
Filed : November 30, 1999
Title : ELECTRONIC COUPON DISTRIBUTION SYSTEM
Art Unit : 3622
Examiner : James W. Myhre

Mail Stop Appeal Brief - Patents

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BRIEF ON APPEAL

The Notice of Appeal in this matter was filed with the United States Patent and Trademark Office via facsimile on August 15, 2005.

(1) Real Party in Interest

The real party interest is Coupons, Inc. of Palo Alto, California.

(2) Related Appeals and Interferences

None.

(3) Status of Claims

Claims 1-18 and 22-46 are pending. Claims 19 - 21 have been canceled. Claims 1-18 and 22-46 stand rejected. The rejection of claims 1-18 and 22-46 is appealed.

(4) Status of Amendments

There are no unentered amendments.

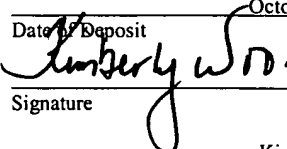
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(5) Summary of Claimed Subject Matter

The claimed subject matter relates to a system and techniques for the electronic distribution of coupons. *See* Specification, FIG. 1 and page 6, lines 5-8.

A client application 28 on a client system 14 periodically communicates with a server system 12 to obtain electronic coupons. *See* Specification, FIGS. 1 and 4, and page 19, lines 12-14. The client application 28 first determines if there is an existing user of the client system 14. *See* Specification, page 19, lines 19-26. If there is not an existing user (*e.g.*, as evidenced by the absence of a file containing a device ID), the client application 28 collects user information indicative of one or more demographic characteristics of the user (*e.g.*, a postal zip code and a state) but does not obtain any information that would be sufficient to specifically identify the user. *See* Specification, page 19, lines 27-36.

The demographic information is provided to the server system 12 for use in selection of coupons appropriate for the user. *See* Specification, page 20, lines 1-18. The server system 12 registers the new user by allocating a device ID. *See id.* A device ID does not specifically identify the user. *See* Specification, page 10, lines 9-12. Rather, the device ID associates a physical machine defining the client system 14 with the user's demographic information. *See id.*

Once a user is registered with the server system 12, the client application 28 can obtain coupons from the server system 12. The server system 12 sends to the client application 28 a list of coupons that the client application 28 has not yet downloaded based on the device ID of the client system 14. *See* Specification, page 22, lines 6-10. The client application 28 can then download the coupons identified in the list from the server system 12. *See* Specification, page 22, lines 21-25.

A Uniform Resource Locator (URL) can be associated with the downloaded electronic coupons to allow a user to redeem the coupons electronically. *See* Specification, page 17, lines 8-16. (However, the URL associated with the coupon is kept hidden from the user. *See* Specification, page 17, lines 21-28.) When such a coupon is displayed by the client application 28, a user can click on a user interface button to invoke a web browser. *See* specification p. 17, lines 17-21. The web browser is directed to the website specified by the URL associated with the displayed coupon. *See id.* Appended to the URL is a promotion code which can be

processed by the website to allow the user to redeem the coupon. *See* Specification, page 17, lines 28-31.

(6) Grounds of Rejection

Claims 24 and 25 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over Barnett (U.S. Pat. No. 6,321,208).

Claims 1-18 and 22-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Barnett in view of Stewart (U.S. Pat. No. 5,835,061).

Claims 26, 36-38 and 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stewart in view of Ogasawara (U.S. Pat. No. 6,123,359).

Claims 27-35, 39-43 and 45-46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stewart in view of Ogasawara and in further view of Barnett.

(7) Argument

I. Rejection under 35 U.S.C. § 102(e) as being unpatentable over Barnett.

Claim 24

Claim 24 stands rejected as being unpatentable over Barnett. Claim 24 recites in part, associating a Uniform Resource Locator (URL) with a coupon, a promotional code being appended to the URL; and invoking use of the URL with a browser to thereby enable a user to redeem the coupon.

Barnett describes a system for electronic distribution of coupons to personal computers located at users' homes. *See* Barnett, *Abstract*. A user can utilize a personal computer 6 to print coupons obtained from an online service provider 2. *See* Barnett, col. 7, lines 2-21 and FIG. 1. Each printed coupon includes a user ID bar code 90 that uniquely identifies the user. *See* Barnett, col. 7, lines 22-33 and FIG. 5. For example, the bar code 90 might encode a user's name, social security number or email address. *See id*; *see also* Barnett, col. 13, lines 54-59. Coupons can also be redeemed electronically by sending the coupon data stored in a printer

output buffer 28 to the online service provider 2 via a data communications interface 20. *See Barnett*, col. 11, lines 29-43, and FIG. 2.

Barnett does not disclose a URL associated with a coupon. Instead, coupons are associated with variable coupon data and fixed coupon parameters, *i.e.*, an expiration date, a redemption amount, company and product data, a UPC code, a redemption address, an offer description, border graphics, redemption instructions and, as described above, a user ID bar code. *See Barnett*, col. 10, line 58 – col. 11, line 28. Barnett does not characterize any of this information as being a URL or being associated with a URL.

Assuming for argument's sake that Barnett discloses a URL associated with a coupon (which it does not), Barnett does not disclose or suggest a promotion code as required by claim 24. Despite this, the Examiner asserted that the user ID bar code 90 in Barnett was analogous to a promotion code. *See* page 4 of the Office Action mailed February 14, 2005. But, as discussed above, the user ID bar code is a code for identifying a user, not a promotion. Furthermore, the bar code is printed on a coupon, not appended to a URL. *See Barnett*, col. 7, lines 22-33 and FIG. 5. In fact, nowhere does Barnett disclose or suggest manipulating a URL to enable a user to electronically redeem a coupon.

Barnett also does not teach or suggest invoking a web browser with the URL associated with a coupon in order to enable a user to redeem the coupon. In contrast to invoking a web browser, Barnett discloses sending coupon data in an output buffer 28 to an online service provider 2 via data communications interface 20 (*e.g.*, a modem). *See Barnett*, col. 11, lines 34-37; col. 8, lines 52-68. The coupon data is transmitted to the address of the online service provider, not an address associated with a coupon. *See id.* Furthermore, Barnett teaches that users interact with online service provider 2 by using a special-purpose data management program (as illustrated in FIG. 4a) as apposed to a web browser. *See Barnett*, col. 7, line 56 – col. 8, line 5.

Accordingly, the rejection of claim 24, as well as the rejection of claim 25 which depends from claim 24, must be overturned.

II. Rejection under 35 U.S.C. § 103(a) as being unpatentable over Barnett in view of Stewart.

Claim 1

Claim 1 recites in part, collecting device information from a client system, the device information being insufficient to specifically identify the user; associating a device ID with the device information at a main server system, the device ID being insufficient to specifically identify the user.

Stewart describes a mobile communications service having mobile units 5, access points 10, and an information provider 20. *See Stewart*, col. 3, lines 45-56 and FIG. 1. Mobile units roam and communicate wirelessly with access points that are in their communication range. *See Stewart*, col. 2, lines 37-47. When a mobile unit 5 is in range of an access point 10, the access point 10 recognizes the user associated with the mobile unit 5, and allows the mobile unit 5 to send and receive information (e.g., email, voice mail) via the access point 10. *See id.*

As a preliminary matter, Appellant asserts that the mobile communication system described in Stewart is non-analogous art. The Federal Circuit Court of Appeals in In re Clay, 966 F.2d 656, 23 U.S.P.Q. 2d 1058, 1060-61 (Fed. Cir. 1992)(emphasis added) held that:

[a] reference is reasonably pertinent if ... it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem.... *If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem....* [I]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.

The problem being solved in Stewart (i.e., providing a mobile communication system) is not even remotely analogous to Appellant's invention for providing an electronic coupon distribution and redemption system. Stewart seeks to solve a *different problem* than Appellant's, that of providing mobile communication. Hence, there would be no motivation for one of skill in the art to rely on Stewart.

Secondly, even assuming for argument's sake that Stewart is analogous art (which Appellant does not concede), claim 24 from which claim 1 depends is not rendered obvious by Barnett in view of Stewart. As discussed above, Barnett does not anticipate claim 24. Stewart

does not remedy the deficiencies in Barnett. Stewart does not disclose or suggest associating a URL with a coupon, appending a promotion code to the URL, and invoking a web browser with the modified URL.

Thirdly, again assuming arguendo that Stewart is analogous art (which Appellant does not concede), claim 1 is not rendered obvious by Barnett in view of Stewart. The Examiner conceded that Barnett does not disclose collecting a device ID from a client system where the device ID is insufficient to specifically identify the user. See Office Action mailed February 14, 2005, page 4. The Examiner argued that Stewart remedies this deficiency in Barnett by disclosing a mobile unit identification code that is not sufficient to specifically identify a user. However, the very text relied upon by the Examiner for this proposition says the opposite:

In addition, mobile unit 5 would also be equipped with a code generator which generates an identification code that can be transmitted to and recognized by the access point 10 or a system accessed through access point 10. Such an identification code allows recognition of a user before providing access to system services, thereby providing a measure of security and a service billing mechanism.

Stewart, col. 3, lines 55-63 (emphasis added).

Furthermore, Barnett cannot be modified as the Examiner proposes. If user ID's in Barnett were replaced with anonymous identification codes for a user's personal computer, there would be no accurate tracking of coupon usage by specific users. According to Barnett:

Further, and quite importantly, the present invention provides for the printing on each coupon of certain user-specific data, thus making each coupon printed unique. Thus, two different users with access to printing a particular coupon will each print coupons with the same product, discount, and expiration date data, yet each will be unique since printed thereon will be user-specific data, preferably in the form of a user-specific bar code. Thus, any attempts to duplicate via photocopying techniques any particular coupon will be discouraged since the coupon redemption center will detect when a particular coupon has been redeemed, will identify the user who redeems a particular coupon, and will disallow any attempt at redemption of a second coupon with identical product and user-specific data.

Barnett, col. 5, lines 49-62 (emphasis added). Thus, removing the ability to associate a user with a coupon will defeat one of the primary objectives of the system described in Barnett, that of preventing fraud. Hence, there would be no motivation to combine Barnett with Stewart.

Accordingly, the rejection of claim 1, as well as claims 2-18 which depend from claim 1, must be overturned.

Claims 22 and 23

Claim 22 depends from claim 24. As argued above, Barnett in combination with Stewart does not render claim 24 obvious. Accordingly, the rejection of claim 22, as well as the rejection of claim 23 which depends from claim 22, must be overturned.

III. Rejection under 35 U.S.C. § 103(a) as being unpatentable over Stewart in view of Ogasawara.

Claim 26

Claim 26 recites in part (emphasis added), collecting device information from a client system, the device information being insufficient to specifically identify a user of the client system; and associating a device ID with the device information at a main server system, the device ID being insufficient to specifically identify the user; and selecting a coupon according to the device ID to thereby identify the coupon appropriate for said user based on the device information.

As argued above, Stewart is non-analogous art. Hence, there would be no motivation for one of skill in the art to rely on Stewart.

Assuming for argument's sake that Stewart is analogous art (which Appellant does not concede), the Examiner vaguely asserted that "in most embodiments [] the system [in Stewart] 'knows' the identity of the user to which the remote device has been assigned." See Office Action mailed February 14, 2005, page 13. However, this is not in accord with what Stewart actually discloses. As discussed above, the mobile unit identification code in Stewart always "allows recognition of a user." Stewart, col. 3, lines 55-63. Therefore, the mobile unit identification code in Stewart is not insufficient to specifically identify a user.

The Examiner argued that Ogasawara discloses an anonymous mobile terminal ID. Based on this, the Examiner asserted that Stewart could be modified to use an anonymous mobile unit ID – one that could not be correlated with a user identity. Appellant respectfully disagrees. Stewart requires identification of the user:

According to the invention, mobile users communicate with wireless local area networks within the range of an access point (AP). When a user passes an access point, the access point recognizes the user, and the user's device can then retrieve data (telephone, E-mail messages, etc.) waiting for the user and transmit information (E-mail messages, print documents, requests for information from service providers, etc.) that the user may have for transmission to a desired recipient. For instance, this process could occur as a user exits an airplane and is detected by an access point in an airport.

Stewart, col. 2, lines 37-47. If an access point were unable to identify the user, there would be no invention in Stewart. Thus, there would be no motivation to combine Stewart with Ogasawara.

The Examiner argues that motivation for eliminating identification of the user in Stewart is found in the following portion of Stewart:

Still another feature according to the invention is the ability to provide customized messages based on the location of the active access point or on the user's profile. For example, a user accessing a network through an access point in a hotel may be provided information about promotions offered by that hotel or other affiliated hotels, airlines, car rental agencies or other providers of goods and services.

Stewart, col. 8, lines 12-19. The above-quoted paragraph from Stewart states that the ability to provide customized messages (*e.g.*, promotions) can be based on the location of the active access point. Therefore, there would be no need to use anonymous mobile unit IDs to accomplish this. Hence, there would be no need to combine Stewart with Ogasawara. Furthermore, such a combination would not render claim 26 obvious since claim 26 requires selecting a coupon according to the device ID collected from a client system – not the location of an access point.

This leads to the inevitable conclusion that the Examiner has employed inappropriate hindsight reconstruction guided solely by the Appellant's disclosure. It is well established that the prior art must be viewed without reading into that art the Appellant's teachings. In re

Sponnoble, 160 U.S.P.Q. 237, 243 (C.C.P.A. 1969). "The issue is whether the teaching of the prior art would, in and of themselves, without the benefit of appellant's disclosure, make the invention as a whole obvious." As the supplied references fail to teach or suggest numerous elements contained within Appellant's claims, it is only by inappropriate hindsight that one might possibly reach the invention from the references supplied.

In view of the foregoing, the rejection of claim 26, as well as the rejection of claims 36-38 which depend from claim 26, must be overturned.

Claim 44

Claim 44 recites in part, means for collecting device information from a user of a client system indicative of one or more demographic characteristics of the user, the device information being insufficient to specifically identify the user; means for associating a device ID with the device information at a main server system, the device ID being insufficient to specifically identify the user; means for selecting coupons according to the device ID to thereby identify coupons appropriate for the user based on the user's demographic characteristics; and, means for transmitting the selected coupons from the main server system to the client system.

For at least the reasons set forth above, specifically that the relied upon portions of Stewart and Ogasawara do not alone or in combination teach or suggest collecting device information from a user of a client system indicative of one or more demographic characteristics of the user, the device information being insufficient to specifically identify the user, and selecting a coupon according to the device ID, claim 44 is allowable.

IV. Rejection under 35 U.S.C. § 103(a) as being unpatentable over Stewart in view of Ogasawara and in further view of Barnett.

Claim 27

Claim 27 depends from claim 26. As argued above, Stewart in combination with Ogasawara does not render claim 26 obvious (assuming they could be combined and that there is motivation to combine, which Appellant does not concede). The mobile unit identification code

in Stewart can be used to specifically identify a user. Ogasawara does not remedy this deficiency. Nor does Barnett:

The online service provider communicates with the personal computer 6 in order to transmit requested coupon data, and also in order to receive coupon requests and the user-specific data mentioned above ... user-specific information such as the user name and/or other unique identification criteria such as a social security number or online service address.

Barnett, col. 7, lines 2-5 and 24-30. Furthermore, the Examiner conceded that Barnett fails to disclose collecting device information that is insufficient to identify a user. See Office Action mailed February 14, 2005, page 4.

In view of the foregoing, the rejection of claim 27, as well as the rejection of claims 28-35 and 39-43 which depend from claim 27, must be overturned.

Claim 45

Claim 45 recites in part, wherein said collecting means includes means for obtaining from the user demographic characteristics including at least one of a postal zip code associated with the user and a state in which the user resides.

Claim 45 depends from claim 44. For at least the reasons set forth above, specifically that the relied upon portions of Stewart, Ogasawara and Barnett, do not alone or in combination teach or suggest collecting device information from a user of a client system indicative of one or more demographic characteristics of the user, the device information being insufficient to specifically identify the user, and selecting a coupon according to the device ID, claim 45 is allowable.

Claim 46

Claim 46 recites in part, means for associating the device ID with the client system, the main server system using the device ID to identify the client system.

Claim 46 depends from claim 44. For at least the reasons set forth above, specifically that the relied upon portions of Stewart, Ogasawara and Barnett, do not alone or in combination teach or suggest collecting device information from a user of a client system indicative of one or

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more demographic characteristics of the user, the device information being insufficient to specifically identify the user, and selecting a coupon according to the device ID, claim 46 is allowable.

V. CONCLUSION AND RELIEF

Based on the foregoing, Appellant requests that the Board overturn the Examiner's rejection of all pending claims and hold that all of the claims of the present application are allowable.

The brief fee of \$250 is enclosed. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 10-14-2005



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Appendix of Claims

1. The method of claim 24 further including the steps of:
collecting device information from a client system, the device information being insufficient to specifically identify the user;
associating a device ID with the device information at a main server system, the device ID being insufficient to specifically identify the user;
selecting said coupon according to the device ID to thereby identify the coupon appropriate for said user based on the device information; and,
transmitting the selected coupon from the main server system to the client system.
2. The method of claim 1 wherein the device information is obtained from the user, the device information including at least one of a postal zip code associated with the user and a state in which the user resides.
3. The method of claim 1 further including the step of:
associating the device ID with the client system, the main server system using the device ID to identify the client system.
4. The method of claim 3 further including the step of:
generating a printed version of the transmitted coupon at the client system.
5. The method of claim 3 further including the step of:
transmitting a request from the client system to the main server system to perform said using step wherein the request includes the device ID.
6. The method of claim 5 wherein said request transmitting step includes the substep of:
automatically including the device ID in the request without any intervention by the user of the client system.

7. The method of claim 5 wherein said request transmitting step occurs automatically without any intervention by the user.

8. The method of claim 7 wherein said request transmitting step occurs at predetermined intervals.

9. The method of claim 3 wherein the client system operates in accordance with an operating system characterized by a graphical user interface (GUI), said method further including the steps of:

displaying an icon visible to the user in a first display state; and,
displaying the icon in a second display state different from the first display state when a new coupon is available for the user.

10. The method of claim 9 wherein the second display state is a flashing display state.

11. The method of claim 1 wherein said transmitting step includes the substeps of:
encrypting coupon data corresponding to the selected coupon at the main server system in accordance with a server system encryption strategy; and,
sending the server-encrypted coupon data to the client system.

12. The method of claim 11 further including the step of:
receiving the server-encrypted coupon data at the client system;
encrypting the server-encrypted coupon data in accordance with a client system encryption strategy to thereby generate doubly-encrypted coupon data; and,
storing the doubly-encrypted coupon data on the client system.

13. The method of claim 12 further including the steps of:
decrypting the doubly-encrypted coupon data at the client system; and,
generating a printed version of one of the selected coupon at the client system.

14. The method of claim 3 further comprising the steps of:
transmitting advertising data to the client system; and,
displaying at least a portion of the transmitted advertising data on a display portion of the client system.

15. the method of claim 14 wherein the advertising data comprises a plurality of advertising impressions, and, wherein said displaying step comprises the substep of:
selecting one of the plurality of advertising impressions as a function of a selected subcategory of coupons available on the client system.

16. The method of claim 3 further comprising the steps of:
detecting events occurring at the client system;
storing the detected events in a user history file; and
transmitting the user history file to the main server system.

17. The method of claim 16 wherein said detecting step includes the substeps of:
determining when one of a plurality of advertising impressions has been displayed on a display portion of the client system; and,
determining a sponsor identification of the advertising impression.

18. The method of claim 16 wherein the storing step comprises the substep of:
encrypting the detected events to thereby generate encrypted user event information; and,
writing the encrypted user event information to the client system.

19.-21. Canceled

22. The method of claim 24 further including the steps of:
collecting device information from a device on a network;
associating a device ID with the device information;

selecting said coupon according to the device ID;
encrypting coupon data corresponding to the selected coupon; and transmitting the encrypted coupon data from the main server system to the client system.

23. The method of claim 22 further including the step of:
decrypting the encrypted coupon data to recover the selected coupon.

24. A method of secure electronic coupon distribution comprising the steps of:
associating a Uniform Resource Locator (URL) with a coupon, a promotional code being appended to the URL;
invoking use of the URL with a browser to thereby enable a user to redeem the coupon;
and,
disabling future use of the invoked URL.

25. The method of claim 24 wherein said invoking step includes the substep of selecting the coupon by one of clicking on the displayed coupon and clicking on an object different than the coupon displayed to the user.

26. A method of operating an electronic coupon distribution system comprising the steps of:
collecting device information from a client system, the device information being insufficient to specifically identify a user of the client system;
associating a device ID with the device information at a main server system, the device ID being insufficient to specifically identify the user;
selecting a coupon according to the device ID to thereby identify the coupon appropriate for said user based on the device information; and
transmitting the selected coupon from the main server system to the client system.

27. The method of claim 26 wherein the device information is obtained from the user, the device information including at least one of a postal zip code associated with the user and a state in which the user resides.

28. The method of claim 26 further including the step of:
associating the device ID with the client system, the main server system using the device ID to identify the client system.

29. The method of claim 28 further including the step of:
generating a printed version of one of the transmitted coupons at the client system that includes the device ID.

30. The method of claim 28 further including the step of:
transmitting a request from the client system to the main server system to perform said using step wherein the request includes the device ID.

31. The method of claim 30 wherein said request transmitting step includes the substep of:
automatically including the device ID in the request without any intervention by the user of the client system.

32. The method of claim 30 wherein said request transmitting step occurs automatically without any intervention by the user.

33. The method of claim 32 wherein said request transmitting step occurs at predetermined intervals.

34. The method of claim 28 wherein the client system operates in accordance with an operating system characterized by a graphical user interface (GUI), said method further including the steps of:

displaying an icon visible to the user in a first display state; and,
displaying the icon in a second display state different from the first display state when a new coupon is available for the user.

35. The method of claim 34 wherein the second display state is a flashing display state.

36. The method of claim 26 wherein said transmitting step includes the substeps of:
encrypting coupon data corresponding to the selected coupons at the main server system in accordance with a server system encryption strategy; and,
sending the server-encrypted coupon data to the client system.

37. The method of claim 36 further including the step of:
receiving the server-encrypted coupon data at the client system;
encrypting the server-encrypted coupon data in accordance with a client system encryption strategy to thereby generate doubly-encrypted coupon data; and,
storing the doubly-encrypted coupon data on the client system.

38. The method of claim 37 further including the steps of:
decrypting the doubly-encrypted coupon data at the client system; and,
generating a printed version of one of the selected coupons at the client system.

39. The method of claim 28 further comprising the steps of:
transmitting advertising data to the client system; and,
displaying at least a portion of the transmitted advertising data on a display portion of the client system.

40. The method of claim 39 wherein the advertising data comprises a plurality of advertising impressions, and, wherein said displaying step comprises the substep of:

selecting one of the plurality of advertising impressions as a function of a selected subcategory of coupons available on the client system.

41. The method of claim 28 further comprising the steps of:
detecting events occurring at the client system;
storing the detected events in a user history file; and,
transmitting the user history file to the main server system.

42. The method of claim 41 wherein said detecting step includes the substeps of:
determining when one of a plurality of advertising impressions has been displayed on a display portion of the client system; and,
determining a sponsor identification of the advertising impression.

43. The method of claim 41 wherein the storing step comprises the substep of:
encrypting the detected events to thereby generate encrypted user event information; and,
writing the encrypted user event information to the client system.

44. A coupon distribution system, comprising:
means for collecting device information from a user of a client system indicative of one or more demographic characteristics of the user, the device information being insufficient to specifically identify the user;
means for associating a device ID with the device information at a main server system, the device ID being insufficient to specifically identify the user;
means for selecting coupons according to the device ID to thereby identify coupons appropriate for the user based on the user's demographic characteristics; and,
means for transmitting the selected coupons from the main server system to the client system.

45. the system of claim 44 wherein said collecting means includes means for obtaining from the user demographic characteristics including at least one of a postal zip code associated with the user and a state in which the user resides.

46. The system of claim 45 further including means for associating the device ID with the client system, the main server system using the device ID to identify the client system.